



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON, SUITE 4600
CHICAGO, IL 60602

COPY MAILED

MAR 02 2007

OFFICE OF PETITIONS

In re Application of :
Steven M. Golden et al :
Application No. 09/490,362 : ON PETITION
Filed: January 24, 2000 :
Attorney Docket No. 2166 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 18, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision of June 29, 2006, by the Board of Patent Appeals and Interferences. Therefore, the proceedings as to the rejected claims were terminated; see 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on August 30, 2006. See MPEP 1214.06.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either

the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks items (1) and (4).

As to item (1), the Examiner has indicated that the filing of the terminal disclaimer to obviate the obviousness-type double patenting rejection would not at this time *prima facie* place this application in condition for allowance since a further search and examination of the application would be required. Accordingly, the reply required must be either a request for continued examination under 37 CFR 1.114 or the filing of a continuing application under the provisions of 37 CFR 1.53(b). If the reply is the filing of a continuing application, the renewed petition under 37 CFR 1.137(b) should so indicate and state that this application is to be expressly abandoned as of the filing date granted to the continuing application.

Turning next to item (4) above, a terminal disclaimer (and fee) is required for a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, where the application became abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order. The reason being that utility and plant applications issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension under former 35 U.S.C. 154(b) (as a result of the Uruguay Round Agreements Act (URAA)). See 35 U.S.C. 154(b) (1999); see also 37 CFR 1.701. If such an application is abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order, the patentee of a patent issuing from such an application is eligible for patent term extension for the entire period of abandonment. The requirement for a terminal disclaimer for these situations will make certain that any patent term extension obtained for the period of abandonment while the application is under appeal, interference, or a secrecy order will be dedicated to the public. Accordingly, the filing of a terminal disclaimer pursuant to the provisions of 37 CFR 1.137(d) is required.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

A handwritten signature in cursive script, reading "Frances Hicks". The signature is written in dark ink and is positioned above the printed name.

Frances Hicks
Petitions Examiner
Office of Petitions